REMARKS

Claims 1-13 and 56-85 are pending in the application.

Claims 1-13 and 56-85 stand rejected.

Claims 1, 57, and 71 have been amended.

Claim Rejections - 35 U.S.C. § 101

Claims 1-13, 56 and 71-85 stand rejected under 35 U.S.C. § 101.

Claim 1 has been amended to indicate that at least the last three elements are "performed using a computer system" and, thus, tied to a particular machine in compliance with *in re In re Bilski*, 545 F.3d 943 (Fed. Cir. 2008).

Claims 71-85 have been amended to recite a "tangible, non-transitory computer readable medium", thus, excluding 'signals' as proscribed by *in re Nuijten*, 500 F.3d 1346 (Fed. Cir. 2007).

Applicants respectfully request withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 1-8, 56-64, 70-78, 84 and 85 stand rejected under 35 U.S.C. § 103 (a) as being unpatentable over eWorkbench, as disclosed in *Meyer* ("eWorkbench: Real-time Tracking of Synchronized Goals), *Dutton* ("Making Reviews More Efficient and Fair") and Mottl ("Appraisal Software Ends HR Paper Chase"), in view of Beaven et al U.S. Publication No. 20040186762 (referred to herein as *"Beaven"*). Applicants respectfully traverse the rejection.

Initially, Applicants note that claims 1, 56, and 71 have been amended to replace "upon modification of the primary goal" with "when the primary goal is modified" to indicate that at least one primary goal will be modified. Additionally, claims 1, 56, and 71 have been amended

to include "executing goal alignment code". Support for the amendments is found in, for example, Figures 5 and 9 and page 20, line 17 through page 21, line 20.

Claims 1, 56, and 71 now explicitly recite "goal alignment code". The "goal alignment code" is clearly not "non-functional descriptive material" but is actual code that performs at least two specific functions, namely, "executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning ... ."

As established in Applicants' request for continued examination submission of June 26, 2009, *Meyer* in view of *Dutton* neither teaches nor suggests "executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal." Claims 1, 57, and 71. The Examiner cites Beaven Provisional Application No. 60/133,152 ("*Beaven Provisional*") as providing the missing teaching. As cited by the *Office Action*, the *Beaven Provisional*, p. 21, lines 8-11 states:

> Users can also execute searches by name or word in the title of a goal or project, and can put Alerts in place that will flag changes that occur in goals or projects previously indicated as being of particular interest.

Thus, the Alerts of *Beaven Provisional* "will flag changes that occur in goals or projects." Figures 31 and 32 of the *Beaven Provisional* provide examples of setting the Alerts. Referring to Figure 31, an Alert can be set for a "start/finish data change", and Alert can be set for "any change" in Increase PR for CI image, and so on. However, none of the Alerts are related to "alignment between the modified primary goal and the secondary goal" as required by claims 1, 57, and 71. All of the Alerts taught by the *Beaven Provisional* relate only to "changes that occur in goals or projects previously indicated as being of particular interest."

> As observed by the Examiner, the *Beaven Provisional*, p. 31, line 21-p. 32, line 4 teaches:
>
> links to any knowledge sources that the initiative team has chosen to put here so that the knowledge sources will be accessible to any members when necessary. An advantage of this facility is that with the domain structure linked to goals and initiatives and with knowledge linked to the goals and initiatives, the organization

is provided with a clear and natural organization for placing and locating critical information when needed.

Thus, *Beaven Provisional* teaches a domain structure that provides links provide users with knowledge about goals and initiatives. The domain structure simply provides some knowledge about a goal. However, providing knowledge about a goal and initiative does <u>not</u> teach or suggest an "executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal" as required by claims 1, 57, and 71.

The Examiner also cites the *Beaven Provisional* as teaching that a user can link strategic corporate goals and Information Technology initiatives. However, Applicants located no teachings to suggest that the *Beaven Provisional* teaches that the Information Technology initiatives are "secondary goals". Even assuming *arguendo* that the Information Technology initiatives are secondary goals, the *Beaven Provisional* still provides no teachings that the Alerts would indicate an "alignment warning".

Thus, *Beaven Provisional* neither teaches nor suggests "executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal" as required by claims 1, 57, and 71. *Beaven Provisional* simply teaches setting an Alert related to a particular goal without regard to an alignment warning.

Accordingly, *Meyer* in view of *Dutton* and the *Beaven Provisional* neither teach nor suggest claims 1, 57, or 71 or claims directly or indirectly dependent thereon.

Claim Rejections - Double Patenting

Claims 1-8, 56-64, 70-78, 84, and 85 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-38 of U.S. Patent No. 7,110,988 ('988 Patent). Applicants respectfully traverse the rejection.

"A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s)." MPEP §804. "In determining whether a nonstatutory basis exists for a double patenting rejection, the first question to be asked is - does any claim in the application define an invention that is >anticipated by, or is< merely an obvious variation of >,< an invention claimed in the patent?" *Id.*

The Examiner states that, "Although the conflicting claims are not identical, they are not patentably distinct from each other because deleting elements from the claims in the related patent would have been obvious." *Office Action*, p. 15. The Examiner cites *In re Karlson*, 311 F.2d 581 (CCPA 1963) as a basis for the Examiner's *prima facie* case of obviousness. Specifically, the Examiner states that, "Elimination of an element of its functions is deemed to be obvious in light of prior art teachings of at least the recited element or its functions." *Id.*

However, when comparing the claims of the Present Application to the claims of the in the instant case to the '988 Patent, there are numerous differences. Applicants respectfully submit that the claims of the Present Application are not merely a subset of the claims of the '988 Patent. For example, each of the claims in the Present Application include (either directly or through dependency) a limitation related to "executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal". None of the claims in the '988 Patent include any limitation related to "executing alignment code". Thus, *In re Karlson* is inapplicable because the claims of the Present Application clearly do not just delete elements from the claims of the '988 Patent.

The Examiner provides a second basis for the double patenting rejection. The Examiner states that:

> the limitations recited in claims 1-8, 56-64, 70-78, 84, and 85 of the instant application, but not recited in the related patent, are deemed to be obvious features to combine with the claimed invention of the patent because the references cited in the art rejection above collectively teach all of the claimed features and combination of these missing features with the claimed invention of

the related patent would have yielded predictable and expected results and all features would operate the same in combination as they do separately. *Id.*, pp. 15-16.

The second basis for the double patenting rejection appears to rely upon the incorporation of elements in the references cited in the art rejection, i.e. "the <u>references cited in the art rejection</u> above <u>collectively teach</u> all of the claimed features and <u>combination of these missing features</u>." However, Applicants respectfully submit that the question is 'whether any claim of the Present Application is an obvious variation of the claimed invention of the '988 Patent.

The second basis for the double patenting rejection admits that the '988 Patent does not contain all the elements of claims 1-8, 56-64, 70-78, 84, and 85. The question then is whether the combination of elements in the claims of the Present Application is an obvious variation of the claims of the '988 Patent. Each of the claims, either directly or by dependency, of the Present Application include a limitation related to an ""executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal". Applicants respectfully submit the Examiner has cited no elements of any of the claims in the '988 Patent that could represent an obvious variation of ""executing goal alignment code to (i) check for primary goal and secondary goal alignment and ,when the primary goal is modified, (ii) generate an alignment warning with the computer system to provide notice regarding alignment between the modified primary goal and the secondary goal!" as required by the claims of the Present Application.

Accordingly, for at least the foregoing reasons, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection.

CONCLUSION

Applicant respectfully submits that all pending claims are in condition for allowance. Accordingly, Applicant requests that a Notice of Allowance be issued. Nonetheless, should any issues remain that might be subject to resolution through a telephone interview, the Examiner is requested to telephone the undersigned at 512-338-9100.

Respectfully submitted,

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